

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

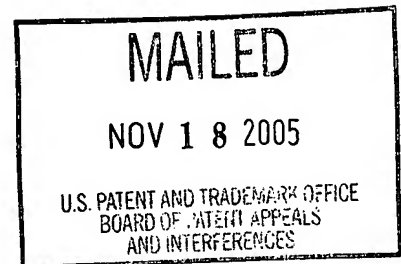
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN R. BROWN

Appeal No. 2005-2601
Application 10/090,885

ON BRIEF



Before WARREN, OWENS and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 10. Claims 11 and 12 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

Claims 1 through 4 illustrate appellant's invention of a container for storing items, and are representative of the claims on appeal:

1. A container for storing items, comprising:
 - a container bottom;
 - a side wall extending upward from said bottom and terminating in a rim defining the periphery of said container, said side wall tapering from top to bottom;
 - a lid covering said container;
 - a surface discontinuity disposed on said side wall intermediate said rim and said container bottom; and

a layer of shrinkwrap, wherein said layer of shrinkwrap is formed to and clings to at least a portion of said tapered side wall, wherein said layer of shrinkwrap is formed to and covers said surface discontinuity and conforms to the shape thereof.

2. The container of claim 1, wherein said layer of shrinkwrap is formed to at least a portion of said lid.

3. The container of claim 2, wherein said shrinkwrap layer further comprises a tear originating at a top portion thereof and extending downward along said side wall, said shrinkwrap layer being substantially separated from said lid and rim yet substantially clinging to said side wall, whereby said lid can be opened or removed yet said shrinkwrap layer clings to said side wall.

4. The container of claim 1, further comprising an adhesive-free label disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in place.

The references relied on by the examiner are:

Ando	3,976,795	Aug. 24, 1976
Karevaara	4,102,454	Jul. 25, 1978
Gray, Jr. (Gray)	5,489,126	Feb. 6, 1996
Marino, Jr., et al. (Marino)	5,605,230	Feb. 25, 1997
Kaufman	6,247,612	Jun. 19, 2001

The examiner has advanced the following grounds of rejection on appeal:

claims 1, 2, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ando (final rejection mailed May 11, 2004 (hereinafter final rejection), pages 2-3);¹

claims 1, 2 and 6 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Karevaara (final rejection, pages 3-5);

claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Karevaara as applied to claim 2, further in view of Marino (final rejection, page 5);

claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Karevaara as applied to claim 2, further in view of Gray (final rejection, pages 5-6); and

claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Karevaara as applied to claim 2, further in view of Kaufman (final rejection, pages 6-7).

Appellants argue appealed claim 1 with respect to the first two ground of rejection, appealed claim 3 with respect to the third ground of rejection, and appealed claim 4 with respect to the last two grounds of rejection. Thus, we decide this appeal based on these claims with respect to said grounds. 37 CFR § 41.37(c)(1)(vii) (September 2004).

¹ The examiner states in the answer (page 3) that the ground of rejection are set forth in the final rejection.

We affirm the grounds of rejection under § 103(a) and we reverse the ground of rejection under § 102(b).

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the answer and to the brief and reply brief for a complete exposition thereof.

Opinion

In order to review the examiner's application of prior art to appealed claims 1, 3 and 4, we must first interpret these claims by giving the terms thereof the broadest reasonable interpretation in their ordinary usage as they would be understood by one of ordinary skill in the art in light of the written description in the specification, unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). As illustrated by specification **Figs. 1-4**, the plain language of claim 1 specifies a container comprising at least, among other elements, a lid **38** and a side wall **34** that tapers upward from the bottom **32** to the top or rim **36** and has any manner of surface discontinuity, such as ridge **46** between the rim and the bottom, wherein any manner of a layer of shrinkwrap, such as **48**, covers and conforms to the surface discontinuity. As illustrated by specification **Fig. 17**, claim 3 specifies that when the shrinkwrap layer **218** is formed to, that is, covers, at least a portion of a lid **208**, as specified in claim 2, in addition to the sidewall **204**, as specified in claim 1, the shrinkwrap layer further comprises at least, at any point in time, a tear, such as **220**, extending from a top portion thereof downward to any extent, however small, along the sidewall in a manner such that the shrinkwrap layer is substantially separated from the lid and rim **206**, so that the lid can be opened or removed, and yet clings to at least a portion, however small, of the side wall. As illustrated by specification **Fig. 17**, claim 4 specifies that the container of claim 1 further comprises at least an adhesive-free label **226** disposed at any position between the shrinkwrap layer and the sidewall.

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with appellant that the examiner has not established, as a matter of fact, a *prima facie*

case of anticipation of appealed claim 1 over Ando within the meaning of § 102(b). The examiner contends that the sidewall of cup body 1 in Ando FIG. 1 terminates “in a rim [R], . . . defined as that planar surface where the lid attaches to the container” with “surface discontinuity [D] . . . disposed on said side wall intermediate said rim and said container bottom,” wherein the “R” and “D” refer to parts of the examiner’s representation of the upper edge of cup body 1 in Ando FIG. 1 set forth in the final rejection, page 2, and the answer, page 4. Appellant submits that Ando “clearly shows that the ‘D’ portion is part of the rim” and “not a separate structure from the rim that is positioned between the rim and bottom of the container,” and “does not define a rim and ‘D’ portion” as required by appealed claim 1 (reply brief, pages 5-6; original emphasis deleted). We agree with appellant. We find that the claim term “rim” is used and illustrated in the written description in the specification, including the drawings, in its customary usage as the top portion of the container side wall that supports the lid and constitutes more than the “planar surface” at the top of the side wall. Indeed, a “rim” can include a rolled edge or projections on the upper side wall as illustrated by rim 36 in specification Fig. 3 and by rim 7 in Karevaara Figs. 1 and 5 as well as a ring of additional material at the top edge of the sidewall as illustrated by the “upper edge” of cup body 1 in Ando FIG. 1 (Ando, col. 2, l. 68, to col. 3, l. 2).

Accordingly, we reverse the ground of rejection of claims 1, 2, 6 and 7 under 35 U.S.C. § 102(b).

We do agree with the examiner that, *prima facie*, the claimed container encompassed by appealed claims 1 and 3 would have been obvious over the combined teachings of Ando and Karevaara² to one of ordinary skill in this art at the time the claimed invention was made. Accordingly, since a *prima facie* case of obviousness has been established, we again evaluate all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant’s arguments in the brief and reply brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

² A discussion of Marino is not necessary to our decision with respect to claim 3. *See In re Kronig*, 539 F.2d 1300, 1302-04, 190 USPQ 425, 426-28 (CCPA 1976).

The examiner finds that the container of Ando does not have a surface discontinuity that is at least one indentation or a ridge as claimed in claims 8 through 10, all directly or ultimately dependent on claim 1, and further finds that Karevaara would have disclosed a cup with a side wall that includes annular projections that comprises a ridge as well as indentations on the inside surfaces of the ridge, as on the representation of outer wall 2 with one of annular projections 5,6 of the container 1 illustrated in Karevaara **FIG. 1** (final rejection, page 4). The examiner essentially concludes that one of ordinary skill in this art would have used the container of Karevaara as the container of Ando “to facilitate separation when stacking the containers in storage or transportation prior to filling with the food product” (*id.*; answer, pages 5-6).

We find that Ando would have disclosed that the “heat-insulated, cup-shaped container 1 . . . is designed for easy handling by hand (either a foamed polystyrene container or a paper cup covered with insulating materials) and suitably contains instant cooking foods,” wherein the “container [is] of a sufficiently small diameter to permit easy gripping and holding by a single hand” and is covered by contractible, that is, shrinkwrap, film 7 “around container 1 and top cover 5” (e.g., col. 1, l. 61, to col. 2, l. 40, and col. 2, l. 55, to col. 3, l. 14). Ando would further have taught that “the container is preferably held by one hand, contractible film 7 is ripped open . . . [and the] cover is pulled open only enough to pour boiling water therein” (col. 3, ll. 19-33). We find that Karevaara would have taught that cardboard drinking mugs with a handle flattened against the side of the disposable cardboard cup or mug, the handle facilitating the drinking of hot beverages, can be efficiently stacked and transported if outer wall 2 has annular projections 5,6 of the container 1 illustrated in Karevaara **FIG. 1** (e.g., cols. 1-2).

We determine that the combined teachings of Ando and Karevaara would have led one of ordinary skill in this art to use the cap-shaped container of Karevaara as the cup-shaped container of Ando in the reasonable expectation of providing a container which can store instant cooking foodstuffs that can later be hydrated with boiling water to form a hot foodstuff, including hot soups, and held in one hand by the handle; the cup-shaped mugs capable of being handled, stored and transported before filling with foodstuffs and sealing with shrinkwrap. Indeed, one of ordinary skill in the art would have recognized that the cup-shaped mug of Karevaara, including the lid thereof, can be covered with a layer of shrinkwrap which can be torn open to at least open

the lid, if not remove the lid, to admit boiling water as taught by Ando. We determine that when the shrinkwrap covering a cup-shaped container as disclosed in Karevaara is torn by a consumer to gain access to the interior of the container through the lid, the tear can extend from a point on the shrinkwrap over the lid downward to some extent along the sidewall in a manner such that the shrinkwrap layer is substantially separated from the lid, that is, the lid can be opened or removed, and yet clings to a portion of the side wall, which is all that is required by appealed claim 3.

We are not convinced by appellant's arguments that one of ordinary skill in this art would not have used the cup-shaped container of Karevaara as the cup-shaped container of Ando because of the utility taught in Karevaara, that is, receiving and holding a hot beverage. This is because this person would have readily recognized that the function of the cup-shaped containers exemplified by Ando and the cup-shaped containers of Karevaara function in the same manner in receiving and containing hot water in a manner such that the cup-shaped container can be held in one hand of a consumer, whether grasping the sidewall of the cup-shaped container or the handle thereof. Furthermore, the cup-shaped containers of each of these references can be shrinkwrapped as taught by Ando.

Accordingly, we are of the opinion that one of ordinary skill in this art routinely following the combined teachings of Ando and Karevaara would have reasonably arrived at a shrinkwrap covered cup-shaped container encompassed by appealed claims 1 and 3, including all of the limitations thereof arranged as required therein, without recourse to appellant's specification. *See In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed] process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the

combined teachings of the references would have suggested to those of ordinary skill in the art.”); *see also In re O’Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988) (“Obviousness does not require absolute predictability of success. . . . There is always at least a possibility of unexpected results, that would then provide an objective basis for showing the invention, although apparently obvious, was in law nonobvious. [Citations omitted.] For obviousness under § 103, all that is required is a reasonable expectation of success. [Citations omitted.]”).

We further agree with the examiner that, *prima facie*, the claimed container encompassed by appealed claim 4 would have been obvious over the combined teachings of Ando, Karevaara and either Gray or Kaufman to one of ordinary skill in this art at the time the claimed invention was made. Accordingly, since a *prima facie* case of obviousness has been established, we again evaluate all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant’s arguments in the brief and reply brief. *See generally, Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

We find that Ando further would have taught that “instructions, identification or other writing” can be included on the lid of the cup-shaped container prior to shrinkwrapping. We find that each of Gray (e.g., abstract, col. 1, ll. 36-60, and col. 3, l. 47, to col. 4, l. 30) and Kaufman (e.g., col. 4, ll. 14-41), would have taught one of ordinary skill in this art that a layer of shrinkwrap can be used to hold a label to the side of an article. Thus, we determine that the combined teachings of Ando and Karevaara as further combined with Gray and with Kaufman would have led one of ordinary skill in this art to hold a label with instructions, identification and other information to the cup-shaped container with shrinkwrap covering the cup and lid in the reasonable expectation of securing the label to the container.

We agree with appellant that neither Gray nor Kaufman pertain to a cup-shaped container covered with shrinkwrap as disclosed by Ando. However, both Gray and Kaufman are clearly applicable references because the teachings thereof with respect to securing a label to an article with shrinkwrap would have logically commended themselves to an inventor’s attention in considering the problem of including a label with the shrinkwrapped cup-shaped container of the

combined teachings of Ando and Karevaara. *See In re Clay*, 966 F.2d 656, 659-60, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Ando and Karevaara alone and as further combined with each of Gray and Kaufman with appellant's countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 10 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

AFFIRMED


CHARLES F. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

Catherine

CATHERINE TIMM
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-2601
Application 10/090,885

Kagan Binder, PLLC
Suite 200 Maple island Building
221 Main Street North
Stillwater, MN 55082